

REMARKS

Claims 1-11 and 13-20 are pending in this application. By this Amendment, claims 13-17, 19 and 20 are amended. No new matter is added. Reconsideration based on the above amendments and following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments amplify issues previously discussed throughout prosecution; (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

I. Rejection Under 35 U.S.C. § 112, First Paragraph

The Office Action rejects claims 1-11 and 13-20 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the rejection.

The Office Action asserts that the specification does not positively recite that a cooling of one component excludes the cooling of other components. Further, the Office Action asserts that the specification is silent as to the components which are not cooled relative to the components that are cooled. Thus, the Office action asserts that the present claims contain new matter.

Claims 13 recites "a cooling device that performs targeted cooling of at least one of the anodes." Claim 15 recites " a cooling device that compulsively performs targeted cooling of at least one of the cathodes." Claim 17 recites "means for performing targeted cooling of

the means for removing contaminants." Claim 19 recites "performing targeted cooling a targeted cooling of at least one of the anodes." Claim 20 recites "means for performing targeted cooling of at least one of the anodes."

In conventional pretreatment methods by sputtering, re-contamination of samples are caused by oxygen levels increasing and becoming unstable when a sequence of analyses are performed. See page 2, lines 1. As a result of examining the causes for re-contamination, Applicants discovered that an electrode surrounding the sample is heated in a sputtering step such that the heating causes a substance absorbed on the counter electrode to be removed thereby re-contaminating the sample. See page 2, lines 2-8. Therefore, Applicants provide pretreatment methods and apparatus for metal samples that prevent the re-contamination of the sample as discussed above. See page 2, line 10-13.

The specification discloses that a targeted cooling site is a site that is heated, or where the temperature increases during sputtering. See page 4, lines 25-26. Thus, the targeted cooling site corresponds to an electrode surrounding the sample as discussed above. Specifically, the specification discloses at least partially cooling one or more of the following targeted cooling sites: Fig. 1 - a metal anode 1; Fig. 2 - a cathode 2; Fig. 3 - metal plates 7 (counter electrodes of the metal sample); and Fig. 4 - anode portions 1. See page 4, lines 26-29, page 5, lines 11-16, page 6, lines 2-6 and 15-23. Therefore, the instant figures and specification provide ample description of the subject matter of the pending claims, such that one of ordinary skill in the art would be well aware that Applicants were in possession of the invention at the time of filing.

Accordingly, the disclosure fully describes the subject matter of claims 13, 15, 17, 19 and 20. Claims 1-11, 14, 16 and 18 are rejected solely for their dependency from claims 13 and 15. Thus, reconsideration and withdrawal of the rejection are respectfully requested.

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claim 17 as being indefinite under 35 U.S.C. §112, second paragraph. Applicants have amended claim 17 to clarify the features thereof. Applicants submit that amended claim 17 is definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. Substantive Examination

The Office Action indicates that patentability cannot be ascertained due to new matter issues. MPEP 2163, Section III, states:

Once Office personnel have concluded analysis of the claimed invention under all statutory provisions, including 35 U.S.C. 101, 112, 102, and 103, they should review all proposed rejections and their bases to confirm their correctness. Only then should any rejection be imposed in an Office action.

Thus, where a *prima facie* case of lack of written description is established, a thorough review of the prior art and examination on the merits for compliance with other statutory requirements, including 35 U.S.C. §§102 and 103, is to be conducted prior to completing an Office Action which includes a rejection for lack of written description. See MPEP 2163. Accordingly, Applicants respectfully request that the Examiner withdraw finality of the Final Rejection, and provide substantive examination of all claims the claims under all relevant statutory provisions (including 35 U.S.C. §§102 and 103), as required by the MPEP.

IV. Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-11 and 13-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Holly N. Moore
Registration No. 50,212

JAO:HNH/kzb

Date: July 30, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--